



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/715,211

11/18/2003

Barry Appelman

06975-455001

2240

26171 7590 07/11/2008

FISH & RICHARDSON P.C.

P.O. BOX 1022

MINNEAPOLIS, MN 55440-1022

EXAMINER

WALSH, JOHN B

ART UNIT

PAPER NUMBER

2151

MAIL DATE

DELIVERY MODE

07/11/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/715,211	Applicant(s) APPELMAN ET AL.	
	Examiner John B. Walsh	Art Unit 2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-21, 38-44 and 58-84 is/are pending in the application.
- 4a) Of the above claim(s) 58 and 59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-21, 38-44, 60-84 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/8/08, 6/17/08</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Newly submitted claims 58 and 59 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Newly presented claims 58 and 59 are drawn to a television programming. These claims appear drawn to an alternate embodiment that is a distinct species from the previously claimed subject matter.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 58 and 59 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: Claim 81 recites “tangible computer-readable medium”.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 77-80 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 77 recites a system. The use of the word “system” does not inherently mean that the claim is directed to a machine. None of the claimed elements of the

Art Unit: 2151

system is a physical part of a device. The specification discloses a GUI, browser, program or code that may comprise the elements of the system (see at least p. 5, line 11; p. 6, line 14 and p. 10, line 10). Thus the system may be implemented as software routines and is thus drawn to computer software per se. See MPEP 2106.01.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 12-14, 16 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 12 and 16 recites the trait information comprises information related to a participation/online status of a user. Claim 12 is dependent upon claim 60 which has distinctly claimed both an online context and trait information. It is unclear how the trait information can then comprise the online context (i.e. participation status).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2151

8. Claims 2, 4-8, 11-21, 38-44, 60, 61, 63-67, 69, 70, 72-81, 83 and 84 are rejected under 35 U.S.C. 103(a) as being unpatentable by U.S. Patent No. 7,299,257 to Boyer et al. in view of U.S. Patent No. 7,092,952 to Wilens.

As concerns claims 60, 76, 77, 81 and 84, determining an online context of a user (429,908; col. 21, lines 50-60); determining an online context of other users (col. 21, lines 43-46); identifying a group of the other users sharing the online context of the user, the number of users in the group of the other users being less than the number of the other users (429,908; col. 21, lines 50-60).

Boyer et al. '257 do not explicitly disclose grouping users based on trait information.

Wilens '952 teaches storing trait information for the user (abstract-profile); storing trait information for each of the other users in the group of the other users (abstract); comparing the stored trait information for the user to the stored trait information for each of the other users in the group of the other users (figure 2); based on the comparison, identifying a subgroup of the group of the other users sharing at least one trait with the user (figure 2); and causing presentation, to the user, of an indicator that identifies at least one user as a member of the subgroup of the other users (figure 2).

As concerns claim 8 and 61, wherein the trait information comprises information related an age (fig. 6A-birth year) of the user or of another user.

As concerns claims 11, 66 and 67, wherein the trait information comprises information related to an interest (figure 6C) of the user or of another user.

It would have been obvious to one having ordinary skill in the art at the time of the invention to provide a means of grouping users based on trait information in order to establish

Art Unit: 2151

relationships with users who have common traits or interests. Such a modification is a combination of known elements yielding predictable results.

Boyer et al. '257 as modified discloses:

As concerns claim 2, wherein determining an online context of the user comprises determining an Internet domain currently accessed by the user (col. 22, line 29).

As concerns claim 4, wherein determining an online context of the user comprises determining a message board (col. 22, line 20-chat, email) currently accessed by the user.

As concerns claim 5, wherein determining an online context of the user comprises determining a URL currently accessed by the user (col. 22, line 29).

As concerns claim 6, wherein determining an online context of the user comprises determining an online context on which the user presently is focused (col. 21, lines 43-60).

As concerns claim 7, wherein identifying other users presently within the online context of the user comprises dynamically identifying users who enter the online context and users who leave the online context (col. 21, lines 50-60; col. 22, lines 9-11).

As best understood concerning claim 12, wherein the trait information comprises information related to a participation status (429,908; col. 21, lines 50-60) of the user or of another user.

As best understood concerning claim 13, the method of claim 12 wherein the information related to the participation status comprises a visibility preference (status is visible, displayed) of the user or of the other user.

As best understood concerning claim 14, the method of claim 12 wherein the information related to the participation status comprises information defining the participation status (figure 10) of the user or of the other user based on multiple online contexts.

As concerns claim 15, wherein the trait information comprises trait information of an individual selected as an associate (associate of the group; col. 23, line 24) by the user or by another user.

As best understood concerning claim 16, wherein the trait information comprises information related to an online status (429,908; col. 21, lines 50-60) of the user or of another user.

As best understood concerning claim 17, the method of claim 16 wherein the online status comprises a status of active, idle, away, and/or mobile (429,908; col. 21, lines 50-60; figure 9).

As concerns claim 18, further comprising storing other information related essentially only to the user or to the other users in the users store related to the online context; and informing the user (figure 9, 908; figure 8) dynamically of the other users based on the stored other information.

As concerns claim 19, wherein the other information comprises information indicative of an identification (figure 8, 419) of the user or of an other user.

As concerns claim 20, the method of claim 19 wherein the information indicative of an identification comprises an online identifier (429,908; col. 21, lines 50-60) associated with the user or with the other user.

As concerns claim 21, the method of claim 18 wherein the other information comprises contact information (fig. 8, 419; fig. 9, 428) of the user or of another user.

As concerns claim 38, further comprising enabling the user to communicate (col. 22, lines 1-8) with at least one of the other users of which the user is informed.

As concerns claim 39, the method of claim 38 wherein enabling the user to communicate the at least one user identified as a member of the subgroup of the other users (col. 22, line 20).

As concerns claim 40, the method of claim 38 wherein enabling the user to communicate with at least one of the other users of which the user is informed comprises enabling (enabling is not a positive limitation, only the ability to perform, since enabling sending of an email does not actually require the email being sent) the user to send an email (col. 22, line 20) to the at least one of the other users.

As concerns claim 41, the method of claim 38 wherein enabling the user to communicate with at least one of the other users of which the user is informed comprises enabling the user (enabling is not a positive limitation, only the ability to perform, since enabling use of voice communication does not actually require the communication to take place) to contact directly the at least one of the other users using a voice communication (col. 22, line 20).

As concerns claim 42, the method of claim 40 wherein the voice communication employs a mobile device (503; col. 13, line 42).

As concerns claim 43, the method of claim 38 wherein enabling the user to communicate with at least one of the other users of which the user is informed comprises enabling the user to store contact information of the at least one of the other users to a contact list (404; figure 8) of the user.

As concerns claim 44, the method of claim 43 wherein the contact list of the user comprises a buddy list (404; figure 8).

As concerns claims 63-65, 69 and 70, wherein a trait and identity of the other user is indicated graphically (figures 8-10; col. 21, lines 50-55).

As concerns claims 72 and 73, wherein the trait information comprises information indicative of a location (col. 23, lines 36) related to the user.

As concerns claims 74 and 75, wherein informing the user dynamically of the other users comprises providing updated information (col. 22, line 11; user makes a change thus affects the reason for an update and the interval) based on a user designated interval.

As concerns claim 77, wherein the other information comprises information based on an activity level (figure 10; 1013, 1001-2; figure 9, 908) associated with the online context.

As concerns claim 78, wherein the users store is migrated based on the activity level (fig. 7 and 10; migrated when created to be stored).

As concerns claim 79, wherein the users store is divided based on the activity level (fig. 7, 415, divided from other data).

As concerns claim 80, wherein the users store is combined with a related users store based on the activity level (fig. 10; 423).

As concerns claim 83, wherein the information indicative of an identification comprises an online identifier (429, 908; col. 21, lines 50-60) associated with the user or with the other user.

Art Unit: 2151

9. Claims 9, 10, 62, 68 and 82 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,299,257 to Boyer et al. in view of U.S. Patent No. 7,092,952 to Wilens as applied above in view of U.S. Patent No. 6,434,599 to Porter.

Boyer et al. as modified do not explicitly disclose the particular claim limitations.

Porter '599 teach:

As concerns claims 9 and 62, wherein the trait information comprises information related to a demographic identifier (figure 6A) of the user or of another user.

As concerns claims 10, 68 and 82, wherein the trait information comprises information related to an expertise rating (figure 6A-interests) of the user or of another user.

It would have been obvious to one having ordinary skill in the art at the time of the invention to provide the particular trait information, as taught by Porter '599, in order to provide a means of providing more information about users to enhance communication.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,299,257 to Boyer et al. and U.S. Patent No. 7,092,952 to Wilens as applied above in view of U.S. Patent No. 6,480,885 to Olivier.

Boyer et al. '257 as modified do not explicitly disclose newsgroups.

Olivier '885 teaches newsgroups (abstract).

It would have been obvious to one having ordinary skill in the art at the time of the invention to provide Boyer et al. '257 as modified with access to newsgroups, as taught by Olivier '885, in order to provide an additional means of communicating, thus increasing the redundancy of the communication system.

11. Claim 71 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 7,299,257 to Boyer et al. and U.S. Patent No. 7,092,952 to Wilens as applied above in view of U.S. Patent No. 5,960,173 to Tang et al.

Boyer et al. do not explicitly disclose sorting.

Tang et al. '173 teach sorting (figure 4; 27).

It would have been obvious to one having ordinary skill in the art at the time of the invention to provide the system of Boyer et al. as modified with sorting, as taught by Tang et al. '173, in order to allow the user to be presented the most relevant information desired in an organized manner.

Response to Arguments

12. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

Art Unit: 2151

the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John B. Walsh whose telephone number is 571-272-7063. The examiner can normally be reached on Monday-Thursday from 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John B. Walsh/
Primary Examiner, Art Unit 2151